

REMARKS

In the final office action mailed April 5, 2006, claims 1-14 and 44-69 were pending. Claims 1, 5-7, 11-14, 44-47, 51-57, 60-69 were finally rejected. Claims 2-4, 8-10, 48-50 and 58-59 were apparently withdrawn, although the final office action did not list these claims as being either pending or withdrawn in the present application. Since these claims have not been cancelled by the applicant, it is believed that these claims would have been indicated as withdrawn based on their status in the first office action. Claims 1, 10, 12, 44, 50, 52, 55, 60 and 62 have been amended in this response. Reconsideration of the present application as amended and in view of the remarks that follow is respectfully requested.

Claims 1, 5, 7, 11, 14, 44, 45, 47, 51, 54-56, 61 and 64-69 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,755,797 to Baumgartner. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

Claim 1 has been amended and recites a system that includes "a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body; voids between respective ones of said plurality of reduction elements; and material filling said voids and locking said plurality of reduction elements relative to one another." There is no disclosure or teaching of these features in Baumgartner. Furthermore, Baumgartner teaches away from material filling voids between the support members and such would render Baumgartner unsuitable for its intended purpose since "during loading, the support members

are elastically deformed, and the compressive forces acting in the direction of the member axis are converted into edges stresses in the annulus fibrosus.” See col. 1, line 62-65.

Therefore, claim 1 and claims 2-14 depending therefrom are allowable.

Claim 44 has been amended and recites a system that includes “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body; voids between respective ones of said plurality of reduction elements; and material filling said voids and locking said plurality of reduction elements relative to one another.” As discussed above with respect to claim 1, Baumgartner fails to disclose these elements. Nor is Baumgartner properly modifiable to include these elements since Baumgartner teaches away from such a configuration. Therefore, claim 44 and claims 45-54 depending therefrom are allowable.


Claim 55 has been amended and is directed to a system that includes “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements include exterior surface means for facilitating engagement between adjacent reduction elements and for facilitating said reduction elements acting randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body; voids between respective ones of said reduction elements; and material filling said and voids locking said plurality of reduction elements relative to one another.” As discussed above with respect to claim 1, Baumgartner fails to disclose these elements. Nor is Baumgartner properly modifiable to include these elements since Baumgartner teaches away from such a configuration. Therefore, claim 55 and claims 56-69 depending therefrom are allowable.

Regarding the withdrawal of claims 8-10, 48-50, 58 and 59, Applicant asserted in the response to the restriction requirement that these claims were readable on the elected species and entitled to examination in the present application. For example, features recited in claims 8, 48 and 58 are shown in Fig. 3, and features recited in claims 9, 49 and 59 are shown in Fig.

4. Figs. 3 and 4 were not set forth as a species in the previous Restriction Requirement. The application discloses that reduction elements having the features shown in Figs. 3 and 4 can be employed with the elected Species I. *See, e.g.*, page 9, line 20 to page 10, line 8 of the specification. In response to applicants' identification of claims readable on the elected species, the Examiner provides a conclusion that these claims are not readable on the elected species, but does not indicate how these claims are not readable on the elected species, nor is there any indication of which species upon which these claims would read. In making the election, applicant relied on the species that were set forth in the Restriction Requirement, and Figures 3 and 4 were not one of the species set forth in the Restriction Requirement. Based on the available species from which to elect and in reliance on the disclosure in the specification linking Figures 3 and 4 to the elected species, claims 8-10, 48-50, 58 and 59 were considered to be readable on the elected species and entitled to examination in the present application. Examination of these claims or clarification of the basis for withdrawal of claims 8-10, 48-50, 58 and 59 in the next communication from the Patent Office is respectfully requested.

Reconsideration of the present application including claims 1-14 and 44-69 in view of this response is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted

By: 

Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
Direct: (317) 238-6333